

REMARKS

In response to the Office Action mailed February 22, 2011, Applicants have amended claim 1 to clarify particular aspects of the present invention. No claims have been cancelled and no new claims have been added. It is urged that support for the claim amendments may be found throughout the as-filed specification and original claims, for example, on page 40, lines 33-34. No new matter has been added. The above amendment is not to be construed as acquiescence with regard to the Examiner's rejections and is made solely to clarify particular aspects of the presently claimed invention, without prejudice to prosecution of any subject matter removed or modified by this amendment in a related divisional, continuation or continuation-in-part application. Following the amendment, claims 1 and 3-10 are pending and under examination. Favorable reconsideration of the subject application is respectfully requested in view of the above amendments and the following remarks.

AMENDMENTS

As an initial point, Applicants, without acquiescence, have amended the claims to recite wherein the vessel is a tube or a well. Support for this amendment may be found throughout the as-filed specification and original claims, for example, on page 40, lines 33-34. No new matter has been added.

SPECIFICATION

The Examiner states that the lengthy specification has not been checked to the extent necessary to determine the presence of all minor errors. Further, the Examiner requests Applicants' cooperation in correcting any error of which Applicants may become aware of in the specification. Applicants have corrected several typographical errors found in the specification. No new matter has been added.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103(A)

Claims 1 and 3-10 stand rejected under 35 U.S.C. § 103(a), as allegedly being unpatentable over Korpela (US Patent No. 6,468,810; "Korpela") in view of Sabloewski *et al.* (US Patent No. 4,041,764; "Sabloewski"). Specifically, the Examiner alleges that Korpela

discloses a device and method for purifying liquids that includes mixing, washing, and changing liquids, but correctly acknowledges that Korpela does not disclose or suggest sleeves made of ferromagnetic material. However, the Examiner further alleges that Sabloewski discloses a liquid transferring device including a ferromagnetic sleeve. Therefore, the Examiner concludes that it would have been obvious to one having ordinary skill in the art at the time of the invention to recognize the sleeves of the magnetic device of Korpela may be manufactured from ferromagnetic material to be used in the process of transferring magnetic particles.

Applicants respectfully traverse this basis for rejection.

The Examiner has the burden to establish a *prima facie* case of obviousness. See, e.g., *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). Obviousness requires that all the claim elements were known or suggested in the art (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and an explicit, apparent reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does with a reasonable expectation of success. See *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1731, 1741 (2007), (“A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art”).

In this case, the Examiner has failed to establish a *prima facie* case of obviousness against the presently claimed invention because both Korpela and Sabloewski, alone or in combination, fail to disclose or fairly suggest a method for handling microparticles that bind a desired component from a sample comprising at least one mixing step and one change of solutions in the same vessel, *i.e.*, a tube or well, as presently claimed. In contrast to the claimed methods, Korpela discloses that the particles are transferred to successive wells to accomplish different treatment steps, *see, e.g.*, column 11 line 64 to column 12, line 4. Further, Sabloewski offers no insight whatsoever to handling microparticles in a single tube or well, because Sabloewski discloses only liquid handling pipette devices. Accordingly, even if one combined Korpela and Sabloewski as suggested by the Examiner, one having skill in the art would not have a reasonable expectation of success in arriving at the presently claimed invention.

Moreover, the Examiner's line of reasoning is insufficient to establish a *prima facie* case of obviousness against the presently claimed invention because the Examiner has not provided any technical evidence or reasoning to support the allegation that a person of ordinary skill in the relevant field would have combined the ferromagnetic sleeve of Sabloewski with the device of Korpela to arrive at the presently claimed invention with any reasonable expectation of success. See *KSR* at 1741, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”).

Assuming, *arguendo*, that each of the references enable what they allegedly teach, there is no motivation to combine the references. As the Federal Circuit has reiterated, “virtually all inventions are combinations of old elements.” *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (1983). Further, the *KSR* Court noted that although an Examiner may often find every element of a claimed invention in the prior art, such a finding is insufficient to support a *prima facie* case of obviousness. *KSR* at 1727, 1741. To properly support a *prima facie* case of obviousness, the Examiner must show a motivation to combine the references. To this end, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998). In the present case, there is no motivation whatsoever to combine the cited references because Sabloewski discloses a ferromagnetic sleeve used for a completely different purpose than the sleeve of Korpela or the sleeve of the presently claimed invention.

Even if the skilled artisan substituted the ferromagnetic sleeve of Sabloewski for the sleeve of Korpela, the skilled artisan would still not have a reasonable expectation of success in deriving the presently claimed invention. Sabloewski discloses that the ferromagnetic sleeve is a component of a detent means that functions to interlock the releasable detent for selecting a predetermined pipetting volume for a liquid pipetting device. See, *e.g.*, col. 8, lines 17-31 and 64-65. In contrast, Korpela discloses that “the membrane 18' can be extended downwards with the aid of the sleeves 26.” See, *e.g.*, col. 9, lines 39-40. Thus, if one combined the elements with

no change in their respective functions, the resulting device would comprise a detent means having a ferromagnetic sleeve for selecting a predetermined volume and a sleeve that extends a membrane covering. **This is not the claimed invention.** Moreover, such a device does not solve the problem solved by the presently claimed invention, namely the efficient handling of microparticles using a device that includes a magnetic tool and a ferromagnetic sleeve to control the magnetic field of the magnetic tool and thus, control the handling of the microparticles. Accordingly, in view of Korpela and Sabloewski, one having skill in the art would not predictably arrive at the presently claimed invention by combining the elements as suggested by the Examiner.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness against the presently claimed invention because both Korpela and Sabloewski fail to teach or fairly suggest a method for handling microparticles that bind a desired component from a sample comprising at least one mixing step and one change of solutions in the same vessel, *i.e.*, a tube or well, and in addition, fail to provide the requisite reason that would have prompted a person of ordinary skill in the relevant field to combine the ferromagnetic sleeve of Sabloewski with the device of Korpela and arrive at the presently claimed invention any reasonable expectation of success.

Reconsideration and withdrawal of this basis for rejection are respectfully requested.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Application No. 10/576,297
Reply to Office Action dated February 22, 2011

All of the claims remaining in the application are now believed to be allowable.
Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,
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